

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/736,282
Inventor(s) : Hiroshi Nakahata *et al.*
Filed : December 15, 2003
Art Unit : 3761
Examiner : Melanie Jo Hand
Docket No. : AA556C
Confirmation No. : 4285
Customer No. : 27752
Title : Absorbent Article Having Extensibility At Waist Panel

APPEAL BRIEF

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Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Dear Sir,

This Brief is filed pursuant to the appeal from the U.S. Patent and Trademark Office Final Rejection dated November 17, 2009 ("Final Rejection"). A timely Notice of Appeal was filed on March 16, 2010.

REAL PARTY IN INTEREST

The real party in interest is The Procter & Gamble Company of Cincinnati, Ohio.

RELATED APPEALS AND INTERFERENCES

There are no known related appeals, interferences, or judicial proceedings.

STATUS OF CLAIMS

Claims 1, 2, 4, 5 and 7-18 are pending and stand rejected. Claims 3 and 6 have been canceled. Claims 1, 2, 4, 5 and 7-18 are being appealed. A complete copy of the appealed claims is set forth in the Claims Appendix hereinbelow.

STATUS OF AMENDMENTS

No amendment was filed subsequent to the Notice of Appeal filed March 16, 2010.

SUMMARY OF THE CLAIMED SUBJECT MATTER

1. Claim 1 relates to an absorbent article having a pair of longitudinal side edges, a first end edge, a second end edge, a first waist panel adjacent to the first end edge, a second waist panel adjacent to the second end edge, a crotch panel positioned between the first and second waist panels, and a side panel extending laterally outwardly from the first or second waist panel (see, *inter alia*, page 4, lines 10 – 20 and FIG. 1), the absorbent article comprising a liquid pervious topsheet, an absorbent core disposed underneath the topsheet, and a chassis layer (see, *inter alia*, page 4, lines 26 – 27 and FIG. 3), wherein the first or second waist panel comprises a portion of the chassis layer (see, *inter alia*, page 5, lines 29 – 30 and FIG. 1), the chassis layer including an inner sheet and an outer sheet joined to one another to form a laminate (see, *inter alia*, page 6, lines 12 – 13 and FIG. 3), a plurality of spaced discontinuities regularly disposed in at least a portion of the first or second waist panel (see, *inter alia*, page 7, lines 23 – 24 and FIG 4) such that when the waist panel is subject to tension the discontinuities provide openings that extend through the laminate of the chassis layer thereby providing the chassis layer with extensibility in the transverse direction (see, *inter alia*, page 7, lines 30 – 31 and FIGS 5 – 6); and an elastic waist band configured as an extensibility controlling means to control the extensibility of the chassis layer (see, *inter alia*, page 12, lines 10 – 13), wherein the elastic waist band inhibits the chassis layer from extending beyond 20% at a tension force of 125 grams/25mm (see, *inter alia*, page 12, lines 13 – 15; and page 11, lines 30 – 32).

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

- 1) Claims 1, 2, 4, 5 and 7 – 18 stand rejected under 35 U.S.C. §112, first paragraph, for not providing enablement for a specific structure or material that inhibits the chassis layer from extending beyond 20% at a tension force of 125 grams/25mm.
- 2) Claims 1, 2, 4, 5 and 7 – 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 5,873,868 issued to Nakahata (hereinafter “Nakahata”) in view of U.S. Pat. No. 6,049,915 to Malowaniec (hereinafter “Malowaniec”).

ARGUMENTS

- 1) **Claims 1, 2, 4, 5 and 7 – 18 are enabled for a specific structure or material that inhibits the chassis layer from extending beyond 20% at a tension force of 125 grams/25mm.**

“The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916), which postured the question: is the experimentation needed to practice the invention undue or unreasonable? That standard is still the one to be applied.” (*In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988)).

The court in *In re Wands* set out the following list of factors to consider when determining whether the experimentation required to practice an invention is undue or unreasonable. (1) the quantity of experimentation necessary, (2) the amount of direction of guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art (7) the predictability or unpredictability of the art, and (8) the breadth of the claims. (*Id.*).

“Whether undue experimentation is needed is not a single, simple factual determination, but rather is a conclusion reached by weighing many factual considerations. (*Martek Biosciences Corp. v. Nutrovina*, 579 F.3d 1363 (Fed. Cir. 2009) citing *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988) (emphasis added).

“As long as the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim, then the enablement requirement of 35 U.S.C. 112 is satisfied.” (*In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970) (emphasis added). “Failure to disclose other methods by which the claimed invention may be made does not render a claim invalid under 35 U.S.C. 112.” (*Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1533, 3 USPQ2d 1737, 1743 (Fed. Cir. 1987), cert. denied, 484 U.S. 954 (1987)).

The Final Rejection states that “the distinction made by the examiner between enablement of an extensibility controlling means, which is present in the disclosure, and enablement of a specific controlling means . . . implicitly involves application of the Wands factors.” (The Final Rejection, page 2). While this may be true, an “implicit” application of the

Wands factors does not provide a clear record of the reasons for rejection to which Appellants can respond. Therefore, Appellants submit that the Office has not properly shown that claims 1, 2, 4, 5 and 7 – 18 are not enabled under 35 U.S.C. § 112, first paragraph.

Appellants appreciate that it is not necessary to discuss each factor in the written enablement rejection. (MPEP §2164.04). But Appellants respectfully remind the Office that the language in the rejection should focus on those factors, reasons, and evidence that lead the examiner to conclude that the specification fails to teach how to make and use the claimed invention without undue experimentation, or that the scope of any enablement provided to one skilled in the art is not commensurate with the scope of protection sought by the claims. (*Id.*).

In the present case, it is Appellants' understanding that the Office has doubt about enablement because information is allegedly missing about one or more essential parts or relationships between parts, which one skilled in the art could not develop without undue experimentation. (See, the Final Rejection, paragraph #5; and the remarks below). The MPEP clearly sets forth that "[i]n such a case, the examiner should specifically identify what information is missing and why one skilled in the art could not supply the information without undue experimentation." (*Id.*) (emphasis added). The MPEP further states that "references should be supplied if possible to support a *prima facie* case of lack of enablement, but are not always required. *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). However, specific technical reasons are always required." (*Id.*) (emphasis added).

In the Final Rejection, the Office asserts that "Appellant discloses only large classes of materials for the topsheet when it functions as the extensibility control means and elastic and inelastic materials for the means when it is not necessarily the topsheet." (The Final Rejection, paragraph #5). The Office also asserts that "the type of material the control means is made of and the structural relationship of the extensibility control means with the rest of the components of the article are both simultaneously responsible for the inhibition of the chassis layer." (The Final Rejection, page 4) (emphasis in original). Based on these assertions, the Office takes the position that one of ordinary skill in the art could not replicate Appellants' claimed absorbent article without undue experimentation. (*Id.*). However, Appellants must point out that the Office has not specifically identified what information is missing nor has the Office provided any evidence or specific technical reasoning to show why one of ordinary skill in the art could not provide the absorbent article recited in claim 1 of the present application without undue

experimentation. Thus, the Office has not made a *prima facie* case. Without providing the requisite evidence or specific technical reasoning to make the *prima facie* case, the Office has improperly shifted the onerous burden to the Appellants to prove that their invention is enabled.

Notwithstanding the lack of the *prima facie* case discussed above, Appellants submit that the present application provides ample disclosure to enable one of ordinary skill in the art to provide the absorbent article recited in claim 1 without undue experimentation. Appellants offer the following remarks in support of this position.

The present application discloses that

The diaper 20 also comprises an extensibility controlling means 70 to control the extensibility of the chassis layer 21. The chassis layer 21 may tear at discontinuities such as slits if the chassis layer 21 is extended beyond the extensibility causing breakage of the chassis layer 21.

(The present application, page 11, lines 26 – 28). The present application goes on to disclose that “the extensibility controlling means 70 inhibits the chassis layer 21 from extending beyond 20 % at tension force of 125 grams/25mm.” (*Id.* at lines 30 – 32).

In the embodiment shown in Figures 1, 4, 5 and 6, the extensibility control means 70 comprises an elastic waist band feature 34 that also facilitates to elastically expand and contract to dynamically fit the wearer's waist. The elastic waist band 34 inhibits the chassis layer 21 from extending beyond extensibility causing breakage of the chassis layer 21 by its resistive force against tension force.

(The present application, page 12, lines 11 – 15) (emphasis added). The present application further discloses that

Alternatively, the extensibility control means 70 may comprise an extensible topsheet material . . . The overall width of the inelastic topsheet when the pleats 24A are extended is limited below the extensibility causing breakage of the chassis layer 21 to inhibit the chassis layer 21 from extending beyond the extensibility causing breakage of the chassis layer 21. Alternatively, the extensibility control means may be . . . an elastic thread, an inelastic thread which is folded before the chassis layer is extended, an elastic film, or an inelastic film which is folded before the chassis layer is extended.

(The present application, page 12, lines 21 – 30).

In view of the foregoing disclosure, Appellants submit that the present application clearly discloses at least one embodiment of an extensibility controlling means that bears a reasonable correlation to the entire scope of this element in claim 1 of the present application. Thus, in accordance with *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970), the enablement requirement of § 112 is satisfied. And as pointed out in *Spectra-Physics, Inc. v.*

Coherent, Inc., 827 F.2d 1524, 1533, 3 USPQ2d 1737, 1743 (Fed. Cir. 1987), cert. denied, 484 U.S. 954 (1987), “[f]ailure to disclose other methods by which the claimed invention may be made does not render a claim invalid under 35 U.S.C. 112.”

2) Claims 1, 2, 4, 5, and 7 – 18 are not unpatentable under 35 U.S.C. §103(a) over Nakahata in view of Malowaniec

To establish a *prima facie* case of obviousness under 35 U.S.C. §103, the Office must show that all of the claim elements are taught or suggested in the prior art. (*CFMT, Inc. v. Yieldup Int'l Corp.*, 349 F.3d 1333, 68 U.S.P.Q.2D 1940 (Fed. Cir. 2003)).

Additionally, an invention composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. (*KSR Int'l v. Teleflex Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007)). There must be a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” (*Id.*) (emphasis added).

The Office and Appellants are in agreement that the combination of Nakahata in view of Malowaniec does not disclose an extensibility controlling means that inhibits the chassis layer from extending beyond 20% at a tension force of 125 grams/25mm. But the Office asserts that this property is inherent to the structure of Nakahata in view of Malowaniec, especially “since the band of the waist feature comprise a material identical to one disclosed by appellant for the elastic band.” (The Final Rejection, page 3, lines 7 – 10).

Appellants respectfully remind the Office that “a retrospective view of inherency is not a substitute for some teaching or suggestion that supports the selection and use of the elements in the particular claimed combination. In deciding that a novel combination would have been obvious, there must be supporting teaching in the prior art; for that which may be inherent is not necessarily known, and obviousness cannot be predicated on what is unknown.” (*In re Newell*, 891 F.2d 899, 13 U.S.P.Q.2d 1248, 1250 (Fed. Cir. 1989) (emphasis added). “Inherency is not necessarily coterminous with knowledge of those of ordinary skill in the art. Artisans of ordinary skill may not recognize the inherent characteristics or functioning of the prior art.” (*Perricone v. Medicis Pharmaceutical Corp.*, 432 F.3d 1368, 77 U.S.P.Q.2d 1321, 1326 (Fed. Cir. 2005) (emphasis added).

Even assuming, for the sake of argument, that the aforementioned property is inherently present in the combination of Nakahata and Malowanec, as asserted by the Office, the Office still has not made a *prima facie* case of obviousness with respect to claim 1. As indicated in the case law cited above, an assertion of inherency cannot be used as a substitute for an element of the *prima facie* case. That is, the Office must still show that one of ordinary skill in the art would be prompted to arrange the elements disclosed in the prior art in the same way that the claimed new invention does (i.e., in a way that provides the claimed parameter). How can it be said that one of ordinary skill in the art would be prompted to combine known elements to provide a claimed parameter when it has not been shown that the parameter is known or recognized in the prior art? Thus, the Office must still provide some objective evidence or reasoning to show that the parameter recited in claim 1 is recognized in the prior art in order to make the *prima facie* case.

SUMMARY

Claims 1, 2, 4, 5 and 7 – 18 have not been properly rejected in the Final Action for all of the reasons discussed above.

The rejection of claims 1, 2, 4, 5 and 7 – 18 appears to be based on an improper enablement analysis as well as an improper obviousness analysis.

As such, the rejections of claims 1 – 18 should all be reversed by the Honorable Board of Patent Appeals and Interferences.

Respectfully submitted,

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Date: April 29, 2010
Customer No. 27752

CLAIMS APPENDIX (Serial No. 10/736,282)

Appealed Claims – Case AA556C

1. An absorbent article having a pair of longitudinal side edges and a first end edge, a second end edge, a first waist panel adjacent to the first end edge, a second waist panel adjacent to the second end edge, a crotch panel positioned between the first and second waist panels, and a side panel extending laterally outwardly from the first or second waist panel, the absorbent article comprising a liquid pervious topsheet, an absorbent core disposed underneath the topsheet, and a chassis layer, wherein at least one of the first and second waist panels comprise a portion of the chassis layer, the chassis layer including an inner sheet and an outer sheet joined to one another to form a laminate, a plurality of spaced discontinuities regularly disposed in at least a portion of the first or second waist panel such that when the waist panel is subject to tension the discontinuities provide openings that extend through the laminate of the chassis layer thereby providing the chassis layer with extensibility in the transverse direction; and an elastic waist band configured as an extensibility controlling means, wherein the elastic waist band inhibits the chassis layer from extending beyond 20% at a tension force of 125 grams/25mm.
2. The absorbent article of Claim 1 wherein the extensibility causing breakage of the chassis layer is more than 20 %.
4. The absorbent article of Claim 3 wherein the extensibility controlling means is disposed in the first or second waist panel in the transverse direction across at least the transverse width of the plurality of spaced discontinuities.

5. The absorbent article of Claim 4 wherein the extensibility controlling means is disposed along an end edge.
7. The absorbent article of Claim 1 wherein the chassis layer comprises a liquid impervious material.
8. The absorbent article of Claim 1 wherein the absorbent article comprises a liquid impervious sheet disposed between the absorbent core and the chassis layer.
9. The absorbent article of Claim 7 wherein the absorbent core does not extend into the first or second waist panel in which the discontinuities are provided.
10. The absorbent article of Claim 8 wherein the absorbent core does not extend into the first or second waist panel in which the discontinuities are provided.
11. The absorbent article of Claim 1 wherein the discontinuities are selected from the group consisting of: slits, cuts, and perforations.
12. The absorbent article of Claim 11 wherein the discontinuities comprise a plurality of cuts wherein the cuts comprise rectilinear cuts, curvilinear cuts, or combinations thereof.
13. The absorbent article of Claim 1 wherein the discontinuities are regularly disposed in the chassis layer.
14. The absorbent article of Claim 1 wherein the discontinuities are oriented such that the discontinuities extend in a longitudinal direction.
15. The absorbent article of Claim 14 wherein the discontinuities are aligned such that the discontinuities form a plurality of laterally spaced columns which extend in the longitudinal direction.

16. The absorbent article of Claim 1 wherein the discontinuities comprise a plurality of edges wherein the edges are treated to strengthen the edges.
17. The absorbent article of Claim 1 wherein the discontinuities are arranged such that the application of a tensile force to the chassis layer results in a plurality of equal area openings having an area from about 1 mm² to about 2500 mm².
18. (Previously Presented) The absorbent article of Claim 1 wherein the discontinuities are arranged such that the application of a tensile force to the chassis layer results in a plurality of openings having an area from about 1 mm² to about 2500 mm².

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EVIDENCE APPENDIX (Serial No. 10/736,282)

No additional evidence is being submitted herewith.

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RELATED PROCEEDINGS APPENDIX (Serial No. 10/736,282)

There is no additional information for the Related Proceedings Appendix in this appeal.